UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

AUG 23 2006

HOFFMANN-LA ROCHE INC.
PATENT LAW DEPARTMENT
340 KINGSLAND STREET
NUTLEY NJ 07110

Paper No. 37

In re Application of	:	
Alfred BINGGELI et al	:	
Application No. 08/711,339	:	ON PETITION
Filed: September 6, 1996	:	
Attorney Docket No. 4019/135	:	

This is a decision on the petition[1] under 37 CFR 1.181, filed February 16, 2006, to withdraw the holding of abandonment. This is also a decision on the petition under 37 CFR 1.181 filed March 2, 2001 (with a certificate of mailing dated March 27, 2000) to invoke supervisory authority of the Commissioner.

The petition to withdraw the holding of abandonment under 37 CFR 1.181 is **GRANTED**.

The petition to invoke the supervisory authority of the Commissioner under 37 CFR 1.181 is **DISMISSED.**

The above-identified application was held abandoned for failure to timely file a proper response to the Office action mailed March 8, 1999, *i.e.*, to limit the claims to the subject matter indicated as being examined. A Notice of Abandonment was mailed December 6, 1999.

Petitioner asserts that the Notice of Abandonment mailed December 6, 1999 should be withdrawn as it was premature because a response to the Office action of March 8, 1999 was filed May 5, 1999.

The Office action mailed March 8, 1999 stated "Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle,* 25 USPQ 74, 1935 C.D. 11; 453 O.G. 213."

MPEP 714.14 states:

> Under the decision in *Ex parte Quayle,* 25 USPQ 74, 1935 C.D. 11; 453 O.G. 213(Comm'r Pat 1935), after all claims in an application have been allowed the prosecution of the application on the merits is closed even though there may be outstanding formal objections which preclude fully closing the prosecution.

Where the claims recite a Markush-type group, applicable USPTO practice permits the examiner for purposes of search and examination, to require applicant to elect a single species. However, this does not support the proposition that when the search and examination determines the elected species is, as here, allowable, applicant is then properly required to restrict his claim(s) to that single elected species. Rather, as set forth in MPEP 803.02, the prior art search is extended as necessary to determine the patentability of the entire Markush-type claim. Where a generic claim links an undue number of independent and distinct species, an applicant is required to elect a single species only for purposes of search and examination. See MPEP 808.01(a). When that search and examination confirms that an allowable generic claim is present, the applicant is permitted to claim a reasonable number of species there under. See MPEP 809.02(c). In neither instance does the administrative expedient of requiring election of a single species to facilitate the ensuing search and examination extend to requiring the applicant to then limit his claims to that single species if it is determined to be allowable, in order to secure the allowance of the application.

The response, filed May 5, 1999, to the Office action of March 8, 1999 states that the application is currently under appeal to the Board of Patent Appeals and Interferences (brief filed February 22, 1999) and is the subject of a Petition to Commissioner (petition filed March 29, 1999). Additionally, the response states the basis for the pending appeal and petition is the requirement of the Office action that "the petition being denied, applicant should limit the claims to the subject matter indicated as being examined."

A basic tenet of practice under *Ex parte Quayle* is that all of the claims have been allowed. Here, where the examiner requires limiting the claims to the subject matter indicated as being examined, all of the claims have not been allowed. Accordingly, the closing of prosecution in accordance with the practice under *Ex parte Quayle* is not proper and the application remained under appeal until the concurrent filing of a Request for Continued Examination (RCE).

In view of the above, the Notice of Abandonment mailed December 6, 1999 is withdrawn as premature and the Office action of March 8, 1999 is vacated.

With respect to the petition to invoke the supervisory authority of the Commissioner, the petition is dismissed as premature because: (1) the concurrently filed RCE has reopened prosecution and the examiner has not yet rendered an Office action failing to consider the claims in their entirety;

and (2) under the authorities of *In re Hass* and *In re Weber* as set forth in the petition, the restriction would be tantamount to a rejection and thus, is subject to appeal to the Board of Patent Appeals and Interferences as there is no petitionable matter. See 37 CFR 1.181.

The application is being referred to the Technology Center AU 1613 for processing of the concurrently filed RCE request and consideration of the concurrently filed petition under 37 CFR 1.103(c).

Telephone inquiries concerning this decision should be directed to David A. Bucci at (571) 272-7099.

John L. LeGuyader
Director TC 1600
571 272 0500

[1] The petition is being treated under the rules and procedures in effect at the time of the Office action in question.